

REMARKS

1. The Amendments, the Support Therefor, and Basis for Entry

Thirteen claims (3, 6-16, and 26) have been canceled, ten new claims (27-36) have been added, and claim 23 is amended to leave claims 21-25 and 27-36 in the application. No new matter has been added by the amendments or new claims. As per 37 CFR §1.116(b) and MPEP 714.12/714.13, the amendment to claim 23 – which incorporates its dependent claim 26 – places the claim either in condition for allowance or in better form for appeal, and thus is believed to be suitable for entry. The new claims 27-36 are believed suitable for entry because these further limit independent claims 21 and 23 – which are allowable for the reasons discussed in subsequent Sections 4-5 of this Response – and because these also primarily merely move certain of the canceled claims dependent from claim 1 to be dependent from claims 21 and 23 instead. To briefly review all amendments and new claims:

- ***Independent claim 23*** is amended to incorporate its dependent claim 26, with claim 26 being clearly allowable for the reasons discussed in Section 5 of this Response, and thus claim 23 is submitted to be allowable;
- ***New dependent claims 27 and 32***, respectively dependent from independent claims 21 and 23, clarify that the delivery conduit and insertion element are separate adjacently-extending elements (a feature clearly shown in the application's drawings), and are submitted to be allowable for at least the same reasons as their parent claims 21 and 23;
- ***New dependent claims 28 and 33***, respectively dependent from independent claims 21 and 23, find support in original claim 3 (now canceled), and are submitted to be allowable for at least the same reasons as their parent claims 21 and 23;
- ***New dependent claims 29 and 34***, respectively dependent from independent claims 21 and 23, find support in original claim 12 (now canceled), and are submitted to be allowable for at least the same reasons as their parent claims 21 and 23;
- ***New dependent claims 30 and 35***, respectively dependent from independent claims 21 and 23, find support in original claim 14 (now canceled) and FIG. 1, and are submitted to be allowable for at least the same reasons as their parent claims 21 and 23;

- *New dependent claims 31 and 36*, respectively dependent from independent claims 21 and 23, find support in original claim 13 (now canceled), and are submitted to be allowable for at least the same reasons as their parent claims 21 and 23.

2. Section 2 of the Office Action: Objection to Claims 3, 6-9, and 11-15

These rejections are obviated by the cancellation of claims 1-20.

3. Sections 1 and 3-4 of the Office Action: Rejection of Claims 1 and 10 under 35 USC §102 in view of U.S. Patent 6,416,522 to Strecker

These rejections are obviated by the cancellation of claims 1-20.

4. Section 5 of the Office Action: Rejection of Claims 21-25 under 35 USC §102(b) in view of U.S. Patent 6,126,633 to Kaji et al.

These rejections are clearly erroneous because *Kaji et al.* does not include all features of claim 21, particularly insofar as:

- (1) *Kaji et al.* does not have an insertion element joiner location pivotally coupled to a delivery conduit joiner location wherein the pivotal coupling – asserted to be tether 4 in (for example) FIG. 1 – fixing the insertion element joiner location and the delivery conduit joiner location at an at least substantially constant distance between each other (as recited in clause b(2) of claim 21). Here, the tether / pivotal coupling 4 extending between the asserted insertion element 1 and the delivery conduit 2 is plainly withdrawable and extendable to provide *variable* distance between the joiner location on insertion element 1 and the joiner location on delivery conduit 2: this is how *Kaji et al.* bends the delivery conduit 2 (see, e.g., FIGS. 8A-8B, column 5 lines 30-34, column 6 lines 9-13).
- (2) *Kaji et al.* also does not have or allow the advancement of the proximal section of the delivery conduit toward the distal end of the delivery conduit with resulting bending of the delivery conduit such that the angle of the distal end of the delivery conduit changes

(as recited in clause b(2) of claim 21). The proximal section of delivery conduit 2 of *Kaji et al.* is fixed to the insertion element 1 (column 5 lines 29-31), and cannot be advanced.¹

As for claim 23 (which has been amended to incorporate claim 26, as discussed in subsequent Section 5 of this Response):

- (1) *Kaji et al.* does not include an elongated insertion element having an outer insertion element surface extending alongside the outer delivery conduit surface and being joined thereto at a joinder location at or adjacent the distal end of the delivery conduit (as recited in clause b(1) of claim 23). Rather, the insertion element 1 extends proximal to (rather than alongside) the delivery conduit 2, and is joined to the delivery conduit 2 at the proximal end of the delivery conduit.
- (2) *Kaji et al.* also does not have or allow the advancement of the proximal section of the delivery conduit toward the distal end of the delivery conduit with resulting bending of the delivery conduit such that the angle of the distal end of the delivery conduit changes (as recited in clause b(2) of claim 23). Again, the proximal section of delivery conduit 2 of *Kaji et al.* is fixed to the insertion element 1 (column 5 lines 29-31), and cannot be advanced.

Claims 21 and 23, and their dependent claims 22 and 24-26, are therefore submitted to be allowable over *Kaji et al.* (Claim 23 is also submitted to be allowable owing to its incorporation of claim 26 – which was not rejected in view of *Kaji et al.* – and owing to the reasons discussed in the subsequent Section 5 of this Response.)

¹ This limitation cannot be neglected merely because it is in a “whereby” clause, since “whereby” clauses can serve to limit claims. See, e.g., MPEP 2111.04 (“[t]he determination of whether [a “whereby” or “adapted to” clause] is a limitation in a claim depends on the specific facts of the case”); *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018, 1023 (Fed. Cir. 1993) (a “whereby” clause that merely states the result of limitations already in the claim adds nothing, whereas a “whereby” clause that recites matter not otherwise required by the claim adds such matter as a limitation).

5. Section 5 of the Office Action: Rejection of Claims 23 and 26 under 35 USC §102(e) in view of U.S. Publ’n. 2005/0251160 to Saadat et al.

Claim 26 has been incorporated into its parent claim 23, and thus these rejections are now only relevant to claim 23.

A review of *Saadat et al.* (and corresponding parent / child application data in PAIR) illustrates that *Saadat et al.*’s earliest claimed priority date is May 7, 2004, whereas the present application has a priority date of February 9, 2004 – prior to *Saadat et al.* – and thus *Saadat et al.* is not prior art. See MPEP 706.02(b); MPEP 2136.05. Claim 23 is therefore in condition for allowance since claim 26 was rejected *only* in view of *Saadat et al.*; since such rejection of claim 26 was clearly erroneous; and since claim 26 is now incorporated into claim 23.

6. Sections 7-9 of the Office Action: Rejection of Claims 3 and 6-8 under 35 USC §103(a) in view of U.S. Patent 6,416,522 to Strecker and U.S. Patent 6,126,633 to Kaji et al.

These rejections are mooted by the cancellation of claims 1-20.

7. Section 10 of the Office Action: Rejection of Claim 9 under 35 USC §103(a) in view of U.S. Patent 6,416,522 to Strecker, U.S. Patent 6,126,633 to Kaji et al., and U.S. Patent 5,462,527 to Stevens-Wright

These rejections are mooted by the cancellation of claims 1-20.

8. Section 11 of the Office Action: Rejection of Claim 9 under 35 USC §103(a) in view of U.S. Patent 6,416,522 to Strecker, U.S. Patent 6,126,633 to Kaji et al., and U.S. Publ’n. 2005/0154401 to Weldon

These rejections are mooted by the cancellation of claims 1-20.

9. In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



Craig A. Fieschko, Reg. No. 39,668
CUSTOMER NO. 25005
DEWITT ROSS & STEVENS S.C.
2 E. Mifflin St., Suite 600
Madison, WI 53703-2865
Telephone: (608) 395-6722
Facsimile: (608) 252-9243
cf@dewittross.com